

REMARKS

Claims 1-28 were pending in the Application. As indicated above, Applicants cancelled claims 22-28 without prejudice or disclaimer. Hence, claims 1-21 are pending in the application.

Claims 1, 10-12 and 18-20 are objected to. Claims 1-9 and 13-21 are rejected under 35 U.S.C. §112, first paragraph. Furthermore, claims 8-9, 15 and 18-21 are rejected under 35 U.S.C. §112, second paragraph. Additionally, claims 1-9 and 13-17 are rejected under 35 U.S.C. §102(b), or in the alternative, under 35 U.S.C. §103(a). In addition, claims 18-21 are rejected under 35 U.S.C. §103(a).

Applicants address these objections and rejections below.

I. OBJECTIONS TO THE CLAIMS:

The Examiner has objected to claims 1, 10-12 and 18-20 for various informalities as discussed on pages 4-5 of the present Office Action. As indicated above, Applicants amended claims 1, 10, 12, 18, 19 and 20 to address these informalities. Accordingly, Applicants kindly request the Examiner to withdraw the objections to the claims.

II. REJECTIONS UNDER 35 U.S.C. §112, FIRST PARAGRAPH:

The Examiner has rejected claims 1-9 and 13-21 under 35 U.S.C. §112, first paragraph, based on a disclosure which is allegedly not enabling. Office Action (8/6/2009), page 2. As indicated above, Applicants amended claim 1 to address the Examiner's concern as discussed on page 2 of the present Office Action. Accordingly, Applicants kindly request the Examiner to withdraw the rejections to claims 1-9 and 13-21 under 35 U.S.C. §112, first paragraph.

III. REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH:

The Examiner has rejected claims 8-9, 15 and 18-21 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Office Action (8/6/2009), page 3. As indicated above, Applicants amended claims 8, 15, 18 and 19 to address the Examiner's concerns as discussed on pages 3-4 of the present

Office Action. Accordingly, Applicants kindly request the Examiner to withdraw the rejections to claims 8-9, 15 and 18-21 under 35 U.S.C. §112, second paragraph.

IV. REJECTIONS UNDER 35 U.S.C. §102/103:

The Examiner has rejected claims 1-9 and 13-17 under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being unpatentable over Nordstrom (U.S. Patent No. 3,719,723). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

As indicated above, claim 1 has been amended to replace the term "including" with "comprising" and clarified to reflect that the steps of the method are successive, namely applying a polymer to a substrate to form a coating, fluorinating the surface of the coating, then curing the coating.

Nordstrom describes a curable paint, but there is no mention of fluorination.

Thus, Nordstrom does not disclose all of the limitations of claim 1, and thus Nordstrom does not anticipate claim 1. M.P.E.P. §2131. Furthermore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 1, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Claims 2-9 and 13-17 each recite combinations of features of independent claim 1, and hence claims 2-9 and 13-17 are not anticipated by Nordstrom for at least the above-stated reasons that claim 1 is not anticipated by Nordstrom. Additionally, claims 2-9 and 13-17 are patentable over Nordstrom for at least the above-stated reasons that claim 1 is patentable over Nordstrom.

V. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 18-21 under 35 U.S.C. §103(a) as being unpatentable over Stirniman et al. (U.S. Patent No. 6,589,641) (hereinafter "Stirniman") in view of Liu et al. (U.S. Patent No. 6,849,304) (hereinafter "Liu"). Furthermore, the Examiner has rejected claims 18-21 under 35 U.S.C. §103(a) as being unpatentable over Liu in view of Stirniman. Applicants respectfully traverse

these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

Claim 18 recites "said method comprising the successive steps of: applying a coating to the substrate surface, said coating being formed from a polymer of which the outer layer includes unsaturated bonds; fluorinating said polymer; and curing said polymer; wherein at least one of the fluorination and curing is performed on the polymer material in a selected pattern so as to provide selectively fluorinated and/or cured portions and selectively unfluorinated and/or uncured portions of said coating."

Stirniman, on the other hand, describes a method of applying a fluoropolymer to a substrate, and the layer is then crosslinked using radiation such as UV (column 4, lines 61-62). This has the result of crosslinking the polymer from the surface of the substrate outward (column 6, lines 60-61). In contrast, the present invention applies a polymer (not a fluoropolymer) and *then* fluorinates the surface of the resulting coating, such that when the coating is cured the crosslinking occurs outwards-in (e.g., paragraphs [0091] and [0097]). As such Stirniman teaches away from the claimed invention of claim 18.

Liu also describes a method of applying a fluoropolymer to a substrate and then curing the same, but again and for the same reasons above this teaches away from the claimed invention of claim 18 in which a polymer is applied to a substrate and then fluorinated.

Thus, Stirniman and Liu, taken in combination, do not teach the successive steps of applying a polymer to a substrate, fluorinating the surface of the resulting coating *in situ*, then curing the coating as recited in claim 18.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 18, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Claims 19-21 each recite combinations of features of independent claim 18, and hence claims 19-21 are patentable over Stirniman in view of Liu (or alternatively,

Liu in view of Stirniman) for at least the above-stated reasons that claim 18 is patentable over Stirniman in view of Liu (or alternatively, Liu in view of Stirniman).

VI. CONCLUSION:

As a result of the foregoing, it is asserted by Applicants that claims 1-21 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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